REMARKS

35 U.S.C. § 112 Claim Rejections

By the Office Action dated June 3, 2003, the Examiner has rejected claims 1-3, 5-15, 22-23, 25, 32-33, and 34-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner has asserted that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (See Office Action, page 2, paragraph 3.) Specifically, the Examiner has asserted that "[t]here is lack of written description to support how a keyword is produced from the search result" and has asked whether "the keyword [is] being produced the same as the input produced by the user or is . . . a new keyword." (See Office Action, page 2, paragraph 3.)

Claims 1-3, 5-14, 22-23, and 25 have been amended for clarification purposes only. Appilcants respectfully submit that no new matter has been added by the amendment to claims 1-3, 5-14, 22-23, and 25. Applicants respectfully submit that claims 1-3, 5-14, 22-23, and 25, as amended, comply with 35 U.S.C. § 112.

Since claim 15 depends on claim 8, since claim 8 depends on claim 6, since claim 6 depends on claim 1, since claims 1, 6, and 8 comply with 35 U.S.C. § 112, and since claim 15 does not describe a keyword being produced from a search result, Applicants respectfully submit that claim 15 complies with 35 U.S.C. § 112.

Since claims 32-33 and 34-37 do not describe a keyword being produced from a search result, Applicants respectfully submit that claims 32-33 and 34-37 comply with 35 U.S.C. § 112.

35 U.S.C. § 102 Claim Rejections

By the Office Action dated June 3, 2003, the Examiner has rejected claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Skillen et al. WO 98/36366 (hereinafter "Skillen"). In order to be an anticipation of a claim under 35 U.S.C. § 102(b), a reference must teach every element of the claim, including the relationships between the elements. If any element is not fully taught by the reference, the rejection cannot be sustained.

Evaluating Skillen in this light, it is appropriate to examine the portions of Skillen which the Examiner has pointed to as teaching the claimed elements.

Claims 1-3, 5-12, 15, 22, 23, and 25

Claim 1

To the extent the Examiner's language at page 3 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 1, as amended:

Claim 1	Skillen
A method of targeting *at least one* associated advertisement from an Internet search having access to an information repository by a user, comprising:	-
identifying at least one *search result item* from a search result of said Internet search by said user;	-
searching for said *at least one* associated advertisement within said repository using said at least one *search result item*;	Skillen does not teach this claim element.
identifying said *at least one* associated advertisement from said repository having *at least one* a word that matches said at least one *search result item*;	Skillen does not teach this claim element.

and correlating said *at least one* associated advertisement with *said at least one search result item*.	Skillen does not teach this claim element.

In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 1, Skillen fails to teach "searching for said *at least one* associated advertisement within said repository using said at least one *search result item*", as required by claim 1. Instead, Skillen teaches away from this claim element by teaching "[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument"; where the initial search argument is not the "at least one *search result item*" required in claim 1. (See Skillen, column 5, lines 58-65 and column 6, line 1.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, column 5, lines 58-65 and column 6, line 1.) In contrast, claim 1 uses the result of an Internet search, the "at least one *search result item*", as an input to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 1.

For similar reasons, Skillen cannot teach "identifying said *at least one* associated advertisement from said repository having *at least one* a word that matches said at least one *search result item*" and cannot teach "correlating said *at least one* associated advertisement with *said at least one search result item*", as required by claim 1. It is therefore clear that Skillen cannot teach each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 102(b) is inappropriate.

Claims 2, 3, 5-12, and 15

Since dependent claims 2, 3, 5, and 6 depend on independent claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claims 2, 3, 5, and 6, and therefore, a rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claims 7-12 depend on claim 6 and since Skillen cannot teach each element of claim 6, Skillen also cannot teach each element of claims 7-12, and therefore, a rejection of claims 7-12 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claim 15 depends on claim 8 and since Skillen cannot teach each element of claim 8, Skillen also cannot teach each element of claim 15, and therefore, a rejection of claim 15 under 35 U.S.C. § 102(b) is inappropriate.

Claim 22

Since claim 22 is the program storage device version of claim 1 with the same elements as claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claim 22, and therefore, a rejection of claim 22 under 35 U.S.C. § 102(b) is inappropriate.
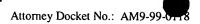
Claims 23 and 25

Since dependent claims 23 and 25 depend on independent claim 22 and since Skillen cannot teach each element of claim 22, Skillen also cannot teach each element of claims 23 and 25, and therefore, a rejection of claims 23 and 25 under 35 U.S.C. § 102(b) is inappropriate.

Claims 16-20, 26-29, 31, 35, and 36

Claim 16

To the extent the Examiner's language at page 4 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 16:

Claim 16	Skillen
A method for providing related advertisements for	-

search result items from a search of an information repository, comprising:	
matching said *search result* items to said related advertisements;	Skillen does not teach this claim element.
designating each of said *search result* items that have said related advertisements matched therewith;	Skillen does not teach this claim element.
providing a corresponding graphical user interface for each of said *search result* items so designated for subsequent user selection;	Skillen does not teach this claim element.
searching and retrieving said related advertisements for one of said *search result* items when said corresponding graphical user interface is selected by a user; and,	Skillen does not teach this claim element.
formatting and displaying said related advertisements upon selection.	-

In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 16, Skillen fails to teach "matching said *search result* items to said related advertisements", as required by claim 16. Instead, Skillen teaches away from this claim element by teaching "[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument", where the initial search argument is not the "*search result* items" required in claim 16. (See Skillen, column 5, lines 34-65 and column 6, lines 1-3.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, column 5, lines 34-65 and column 6, lines 1-3.) In contrast, claim 16 uses the results of an Internet search, the "*search result* items", as inputs to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 16.

For similar reasons, Skillen cannot teach "designating each of said *search result* items that have said related advertisements matched therewith", cannot teach "providing a corresponding graphical user interface for each of said *search result* items so designated for subsequent user selection", and cannot teach "searching and retrieving said related advertisements for one of said *search result* items when said corresponding graphical user interface is selected by a user", as required by claim 16. It is therefore clear that Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 16 under 35 U.S.C. § 102(b) is inappropriate.

Claims 17-20

Since dependent claims 17-20 depend on independent claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claims 17-20, and therefore, a rejection of claims 17-20 under 35 U.S.C. § 102(b) is inappropriate.

Claim 26

Skillen also cannot teach each element of claim 26 for reasons similar to the reasons why Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 26 under 35 U.S.C. § 102(b) is inappropriate.

Claims 27-29

Since dependent claims 27-29 depend on independent claim 26 and since Skillen cannot teach each element of claim 26, Skillen also cannot teach each element of claims 27-29, and therefore, a rejection of claims 27-29 under 35 U.S.C. § 102(b) is inappropriate.

Claim 31

Since claim 31 is the program storage device version of claim 16 with the same elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 31, and therefore, a rejection of claim 31 under 35 U.S.C. § 102(b) is inappropriate.

Claim 35

Since claim 35 is the computer program product version of claim 16 with the similar elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 35, and therefore, a rejection of claim 35 under 35 U.S.C. § 102(b) is inappropriate.
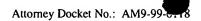
Claims 36

Since dependent claim 36 depends on independent claim 35 and since Skillen cannot teach each element of claim 35, Skillen also cannot teach each element of claim 36, and therefore, a rejection of claim 36 under 35 U.S.C. § 102(b) is inappropriate.

Claims 32-34

Claim 32

To the extent the Examiner's language at page 3-5 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 32:

Claim 32	Skillen
A system for providing associated advertisements for search result items from an Internet search of an information repository, comprising:	-
a user/session manager means for maintaining and tracking *search result items* from user sessions, user queries, and advertisement requests;	Skillen does not teach this claim element.
a product database means for providing storage and retrieval for said associated advertisements;	-
a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and *matching* said associated advertisements from said product database corresponding to each of said *search result items*;	Skillen does not teach this claim element.
a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager; and,	Skillen does not teach this claim element.
a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said *search result items*, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server.	Skillen does not teach this claim element.

In reviewing the cited portions of <u>Skillen</u>, however, it becomes apparent that <u>Skillen</u> has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 32, <u>Skillen</u> fails to teach "a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and *matching* said associated advertisements from said product database corresponding to each of said *search result items*", as required by claim 32. Instead, <u>Skillen</u> teaches away from this claim element by teaching "[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument", where the initial search argument is not the "*search result* items" required in claim 32. (See <u>Skillen</u>, column 5, lines 34-65 and column 6, lines 1-3.) <u>Skillen</u> teaches uses the same search argument for an Internet search for a search of a product database. (See <u>Skillen</u>, column 5, lines 34-65 and column 6, lines 1-3.) In contrast, claim 32 uses the results of an Internet search, the "*search result* items", as inputs to a search of a repository of advertisements. Thus, <u>Skillen</u> cannot teach this element of claim 32.

For similar reasons, <u>Skillen</u> cannot teach "a user/session manager means for maintaining and tracking *search result items* from user sessions, user queries, and advertisement requests", cannot teach "a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager", and cannot teach "a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said *search result items*, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server", as required by claim 32. It is therefore clear that <u>Skillen</u> cannot teach each element of claim 32 and, therefore, a rejection of claim 32 under 35 U.S.C. § 102(b) is inappropriate.

Claim 33

Since dependent claim 33 depends on independent claim 32 and since <u>Skillen</u> cannot teach each element of claim 32, <u>Skillen</u> also cannot teach each element of claim 17-33, and therefore, a rejection of claim 33 under 35 U.S.C. § 102(b) is inappropriate.

Claim 34

Since claim 34 is the computer program product version of claim 32 with the similar elements as claim 32 and since <u>Skillen</u> cannot teach each element of claim 32, <u>Skillen</u> also cannot teach each element of claim 34, and therefore, a rejection of claim 34 under 35 U.S.C. § 102(b) is inappropriate.

35 U.S.C. § 103 Claim Rejections

By the Office Action dated June 3, 2003, the Examiner has rejected claims 13, 14, 21, 30, and 37 under 35 U.S.C. § 103(a) as being unpatentable over <u>Skillen</u>. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating <u>Skillen</u> in this light, it is appropriate to examine the portions of <u>Skillen</u> that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

Claim 13 and 14

Since <u>Skillen</u> cannot teach each element of claim 1, <u>Skillen</u> can neither teach nor suggest each element of claim 1, and, therefore, a rejection of claim 1 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 6 depends on claim 1 and since <u>Skillen</u> can neither teach nor suggest each element of claim 1, <u>Skillen</u> can neither teach nor suggest each element of claim 6 and, therefore, a rejection of claim 6 under 35 U.S.C. § 103(a) would also be inappropriate. Since claims 13 and 14 depend on claim 6 and since <u>Skillen</u> can neither teach nor suggest each element of claim 6,

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Skillen can neither teach nor suggest each element of claims 13 and 14, therefore, a rejection of claims 13 and 14 under 35 U.S.C. § 103(a) is inappropriate.

Claim 21

Since Skillen cannot teach each element of claim 16, Skillen can neither teach nor suggest each element of claim 16, and, therefore, a rejection of claim 16 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 21 depends on claim 16 and since Skillen can neither teach nor suggest each element of claim 16, Skillen can neither teach nor suggest each element of claim 21 and, therefore, a rejection of claim 21 under 35 U.S.C. § 103(a) is inappropriate.

Claim 30

Since Skillen cannot teach each element of claim 26, Skillen can neither teach nor suggest each element of claim 26, and, therefore, a rejection of claim 26 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 30 depends on claim 26 and since Skillen can neither teach nor suggest each element of claim 26, Skillen can neither teach nor suggest each element of claim 30 and, therefore, a rejection of claim 30 under 35 U.S.C. § 103(a) is inappropriate.

Claim 37

Since Skillen cannot teach each element of claim 36, Skillen can neither teach nor suggest each element of claim 36, and, therefore, a rejection of claim 36 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 37 depends on claim 36 and since Skillen can neither teach nor suggest each element of claim 36, Skillen can neither teach nor suggest each element of claim 37 and, therefore, a rejection of claim 37 under 35 U.S.C. § 103(a) is inappropriate.

Conclusion

It is therefore clear that claims 1-3, 5-23, and 25-37 comply with the requirements of 35 U.S.C. §§ 102, 103, and 112. The application is therefore in condition for allowance. Early notification to that effect is respectfully solicited. In the event that any issue remains unresolved, the Examiner is invited to telephone the undersigned at 408-927-3377.

Respectfully Submitted,

Date: September 3, 2003

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